

## REMARKS

Claims 1-14 are pending. Applicants propose amendment of claim 6 in response to a rejection under 35 USC §112, second paragraph. Entry of the amendment after final rejection is earnestly solicited. A marked-up version showing the proposed amendment of claim 6 is attached hereto as "Version with markings to show changes made."

The Office Action notes that claim 1 includes a heavy boarded box around formula (1). A clean version of claim 1 without the heavy boarded box is resubmitted above.

Claim 6 was rejected under 35 USC §112, second paragraph, as being indefinite. Applicants propose amendment of claim 6 to clarify that the color toner is an electrographic color toner. Accordingly, proposed amended claim 6 is in full compliance with 35 USC §112.

Claims 1-6 were rejected under 35 USC §103(a) as being unpatentable over Kushino et al. in view of Yamanaka et al. The Examiner argues that it would have been obvious to prepare Kushino et al.'s toner with the calixarene of Yamanaka et al. because Kushino et al specifically calls for colorless charge control agents and Yamanaka et al. discloses specific colorless calixarenes that serves this function. Applicants respectfully traverse the rejection.

Accordingly to the present invention, a calixarene charge control agent is used in combination with an IR absorbing agent in the photofixing color imaging toner. Surprisingly, the inventors of this application have found that a combination of the calixarene charge control and the IR absorbing agent does not cause any undesirable reaction upon heating during the toner production. As disclosed at page 4, lines 17 to 23 of the specification, in the prior art toners, it was impossible to use both a charge control agent and an IR absorbing agent in combination

because undesirable reactions between these agents can cause a loss of the IR absorbing power and the charging power in the resulting toner.

There must be a basis in the art for combining or modifying the references. The mere fact that the references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. In this regard, Kushino et al. provides specific concrete examples of the charge controlling agent at column 20, lines 12-20. Kushino et al. further states that when the coloring agent is in the form of a color toner producing a color other than black, the charge controlling agent is preferred to have no color or a light color. This statement refers to the concrete examples of the charge controlling noted by Kushino et al. which have no color or a light color.

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The Examiner has mischaracterized Kushino et al. as specifically calling for colorless charge control agents. As noted above, Kushino et al. provides concrete examples of charge controlling agents, and states that for producing a color other than black, the concrete charge control agent is preferred to have no color or a light color.

It is noted that the Examiner argues that there is no indication in the art that calixarenes will react with IR absorbing agents. In this regard, the cited references do not recognize that the infrared absorbing agent compound and the charge controlling agent react with each other during heating when manufacturing the toner. Prima facie obviousness requires a reasonable expectation of success. The Examiner's position appears to be that it would have been obvious to try the calixarene charge control agents in the flash fixing toner of Kushino et al. However, "obvious to try" is an improper basis for an obviousness rejection. There must be a suggestion or expressed expectation of success in the prior art. There is no expressed expectation of success provided by the prior art references.

The Examiner also argues that the obviousness of combining the references is not negated since Yamanaka et al. does not disclose that its compound is effective in a photofixing toner. To the contrary, the fact that Yamanaka et al. does not disclose or suggest that its charge-control agent can be employed in a photofixing toner is further reason why one of ordinary skill in the art would not have combined the references as asserted by the Examiner. One of ordinary skill in the photofixing art may look to teachings of charge-control agents in the photofixing art. As noted above, there would not have been a reasonable expectation of success that the charge-control agents of Yamanaka et al. would be suitable in a photofixing color imaging toner.

Claims 1, 2 and 4-6 were rejected under 35 USC §103(a) as being unpatentable over Ishimaru et al. in view of Yamanaka et al. The Examiner requires a more precise statement regarding the common ownership. The present application and Ishimaru et al. were, at the time the present application was made, owned by Fujitsu Limited. As such, the rejection has been overcome.

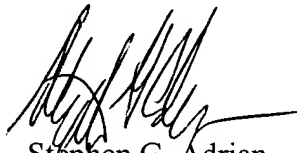
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

In the event that this paper is not timely filed, applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully Submitted,

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PATENT TRADEMARK OFFICE

Enclosure:    Version with markings to show changes made

**IN THE CLAIMS:**

**Claim 6 has been amended as follows:**

6. (Twice Amended) The color imaging toner according to claim 1 or 2, wherein the color toner is [fixed by] an electrographic color toner [imaging process employing a photofixing system].